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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/963, 239 11/03/97 GOUGH

E 13724-787

EXAMINER

021971 QM12/0813  
WILSON SONSINI GOODRICH & ROSATI  
650 PAGE MILL ROAD  
PALO ALTO CA 94304-1050

EEFFLEY M PAPER NUMBER

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3739  
DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b> 08/963,239	<b>Applicant(s)</b> GOUGH ET AL.
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 July 2001 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 47-54 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 47-54 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 03 November 1997 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6)  Other: \_\_\_\_\_

***Priority***

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

Applicant's comments in the preliminary amendment of July 26, 2001 indicate that the instant application claims take priority from the subject matter of US Patent No. 5,536,267. However, there is no specific claim for priority to this application.

It is noted that the instant application incorporates by reference the subject matter of US Patent No. 5,728,143, which incorporates by reference the subject matter of US Patent No. 5,683,384, which incorporates by reference the subject matter of US Patent No. 5,536,267. As such, applicant contends that the instant application therefore effectively incorporates by reference the subject matter of US Patent No. 5,536,267 into the instant application. The examiner has been unable to find any reason to object to such an incorporation by reference. However, it is noted that the inventors, and apparently the assignee, of the '267 patent are entirely different from the inventors of

the instant application. As such, the inventors of the instant application can not claim to be the inventors of the subject matter of the '267 patent even though this subject matter has been incorporated by reference.

Applicant also states in the comments of the July 26, 2001 preliminary amendment that support for the newly added claims 47-54 can be found in the '267 application. Again, in as much as there are no common inventors in the instant application and the '267 application, the inventors of the instant application cannot be the inventors of the subject matter of the '267 application.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the obturator and introducer of claims 48, 49, 53 and 54 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

Claims 47 and 50-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al ('675).

Edwards et al provide an RF device for the treatment of tumors. The ablation device includes a plurality of sharpened electrodes (56) which are deployed into tissue. In a deployed state, the electrodes may take various curved configurations so as to surround a tissue mass as the electrodes are advanced into tissue (see figures 7-9).

Claims 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by LeVeen et al ('276).

LeVeen et al disclose a device for the ablation of tumorous tissue which includes an elongate delivery device (12) and a plurality of electrodes (24) deployable from the delivery device with a changing direction of travel. The electrodes (24) are deployed such that they surround the tissue mass to be ablated (see Figure 1). LeVeen et al further disclose the use of an insulation to control the ablation volume (Figures 7 and 8), as well as the use of an obturator for locating the introducer (i.e. elongate delivery device) within the desired tissue (see Figures 9-14).

While applicant asserts that the subject matter of the instant claims has an effective priority date of August 12, 1994, applicant has failed to properly support such a claim for priority. In particular, there is no express request for priority to the '267 patent. Further, the inventors of the instant application are not among the inventors in the '267 patent and cannot rightfully claim to be the inventors of the subject matter of the '267 patent.

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Claims 47-54 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. As asserted previously, applicant contends that pending claims 47-54 derive support from the '031 application (now US Patent No. 5,536,267). The inventors of the subject matter of the '267 patent are Stuart D. Edwards, Ronald G. Lax and Hugh Sharkey. None of these inventors are listed in the instant application. As such, the inventors of the instant application cannot claim to be the inventors of the subject matter of the '267 patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

*Michael Peffley*  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
August 10, 2001